



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/845,643	04/30/2001	Srikar Rao		3965

7590 12/31/2002
SRIKAR RAO
12096 SAIL PLACE DRIVE
INDIANAPOLIS, IN 46256

EXAMINER

WONG, STEVEN B

ART UNIT	PAPER NUMBER
----------	--------------

3711

DATE MAILED: 12/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/845,643

Applicant(s)

RAO, SRIKAR

Examiner

Steven Wong

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-7,9,10 and 13-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-7,9,10 and 13-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Upon rereading and reconsideration of the reference to Giglio and applicant's remarks and amended claims the indicated allowability of claims 1, 6 and 11 in the Interview Summary is withdrawn.

Claim Objections

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 11-15 have been renumbered as claims 13-17.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 3, 6, 7, 13, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giglio. Regarding claims 1, 6, 13 and 17, Giglio discloses a golf ball marker and holder comprising a clip (20) and a ball marker (24) which is attached to the clip by a magnet (16). The clip defines a circular recessed cavity (32) which receives the ball marker. It would have been obvious to one of ordinary skill in the art to remove the golf tee attachment surface (48) from the accessory of Giglio in order to provide a simpler device. Further, it would have been obvious to

one of ordinary skill in the art to form the clip of Giglio from a monolithic piece in order to simplify construction of the clip by permitting processes such as molding.

Regarding claims 3 and 7, the marker is made from a ferrous material and the ball marker is magnetic.

Regarding claim 16, the ball marker of Giglio obviously possesses a rim that would facilitate removal of the marker from the recess.

Claims 4, 5, 9, 10 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giglio in view of Kennedy. Regarding claims 4, 9 and 15, Giglio provides a means (32) for removing the ball marker from the cavity.

Kennedy reveals a golf mark retaining device including a recess (16) and an indentation (60) for assisting in grasping the ball marker. It would have been obvious to one of ordinary skill in the art to replace the means (32) of Giglio for removing the ball marker from the cavity with the indentation of Kennedy in order to assist the user in removing the ball marker from the cavity.

Regarding claims 5 and 10, Giglio states that it is well known in the art to provide indicia on the top surface of ball markers such as the name of a golf equipment manufacturer (column 2, lines 8-11).

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Giglio in view of Buckman. Buckman discloses a golf ball marker and carrying tool comprising a recess (4) sized for receiving a ball marker (7) and magnet (6). Note Figure 2 which shows the ball marker protruding slightly past the outer surface of the recess. It would have been obvious to one of

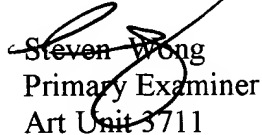
ordinary skill in the art to have the ball marker of Giglio extend slightly past the recess in order to facilitate removal of the ball marker.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Wong whose telephone number is 703-308-3135. The examiner can normally be reached on Monday through Friday 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Sewell can be reached on 703-308-2126. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-3579 for regular communications and 703-308-7768 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.


Steven Wong
Primary Examiner
Art Unit 3711

SBW
December 23, 2002